

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CUSTOMER NO. 22927

Application No.: 09/609,253 **Applicants:** Walker et al. **Filed:** June 30, 2000

Title: METHODS AND APPARATUS FOR INCREASING AND/OR FOR MONITORING A PARTY'S COMPLIANCE WITH A SCHEDULE FOR TAKING MEDICINES

PRE-APPEAL REQUEST FOR REVIEW

Applicants respectfully request Pre-Appeal Review of the rejections set forth in the Final Office Action mailed July 26, 2007 (Paper No./Mail Date 20070720) (hereinafter, the "Final Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

REMARKS

I. Introduction

Claims **2, 3, 5-47, 49-50 and 116-125** are pending, and claims **2, 49 and 116** are the only independent claims. All pending claims stand rejected for allegedly being unpatentable over U.S. Patent No. 5,950,632 (hereinafter "Reber") in view of U.S. Patent No. 6,529,446 (hereinafter "de la Huerga").

Applicants thank the Examiner for withdrawing the 35 U.S.C. §102(a) rejection of claims **49-50 and 116-125** in the Final Action.

Review is requested for the reasons recited below. Please note that, in the arguments, claim limitations are indicated by *italics*.

II. Neither Reber nor de la Huerga Teaches or Suggests Communications Between Two Medicine Containers

Applicants respectfully submit that the Examiner has misinterpreted the teachings of Reber and de la Huerga. Provided immediately below are brief descriptions of what these references teach.

Reber discloses a medical communication apparatus 20 (See Reber, Fig. 1) to assist end users in complying with prescriptions for taking medicine. The apparatus 20 communicates with

a medical database system 24 to alert the end user to take medicine, and is configured to communicate with at least one medicine container 26 that contains the medicine (Fig. 1 and col. 2, line 38 to col. 3, line 8). In a described embodiment, a communication apparatus 50 (Fig. 2) acts as a base station to communicate with one or more medicine containers 52 (col. 4, lines 27-40). In another implementation, a communication apparatus 100 (Fig. 3) communicates with each of three medicine containers (102, 104, 106) by reading machine-readable data (112, 120, 126) from a label (110, 116, 124) attached to each medicine container (col. 7, line 55 to col. 8, line 5). Thus, Reber teaches to use a single, central communication apparatus or base station for communicating with one or more medicine containers.

de la Huerga discloses an interactive medicine container or console that holds or organizes one or more medication containers or vials. Each vial has a memory strip containing medication and prescription information, and the console reads this information and interacts with a patient to remind them to take the medication (see de la Huerga, col. 3, line 62 to col. 4, line 3). In an illustrative embodiment, a medical organizing system 1300 (Fig. 42) has medicine containers that are removably secured to a dispenser 1310 (col. 47, lines 15-18). The dispenser 1310 comprises a housing having slots 1319 that are configured to mate with a plate 1104 of each medicine container (col. 47, lines 35-38). Each medicine container has an interactive label 1106 (see Figs. 35 and 37) that includes a memory strip 60 including contacts 62. When a medicine container is fully engaged in the slot 1319, the contacts 62 physically and electrically connect to contacts 1150 of dispenser 1310 so that a processor 1378 can then read the memory strip 60. Another embodiment includes a container having contacts 62 that are arranged as a series of stripes, and this container fits into a round hole of the dispenser, wherein the round hole is sized such that contacts 1150 of the dispenser are in electrical contact with the contacts 62 of a vial (col. 48, lines 10-26). Each of de la Huerga's example systems require a medicine container to be in electrical contact with contacts 62 of a dispenser to communicate information between the dispenser and the medicine container.

1. Independent Claim 2 is Patentably Distinct From the Cited References

There is no suggestion in Reber or de la Huerga of *wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine* as recited by claim 2. The Examiner asserts that

Reber teaches such a feature at col. 7, lines 43-67 (Final Action, page 3, paragraph “(B)”). But this cited portion of Reber discloses that the medicine containers are capable of communicating only with the medical communication apparatus 50 and *not* with each other. Reber does *not* teach or suggest that the “medical communication apparatus 50” is a medicine container or is adapted to store medicine. Thus, the Examiner has misinterpreted the teaching of Reber.

We respectfully submit that de la Huerga does *not* cure this deficiency of Reber. The Examiner cites de la Huerga at col. 62, lines 10-17 for purportedly disclosing wireless communication between two medicine containers. But this section of de la Huerga merely recites:

“... Specifically, while the invention has been shown and described as including a vial, blister pack or cassette container or aerosol dispenser, it should be understood that other forms of containers could be used with equal effectiveness. For example, the container could be a tray or a cassette that does not include a cap, cover or lid. The memory device or memory strip could also communicate with the processor of the container via RF technology. It should therefore be understood that the container can take on a variety of shapes and forms without departing from the broad aspects of the invention.” (Col. 62, lines 7-17)

This cited passage discloses that a memory device or strip (which is attached to the container) could communicate with the processor of the container via RF technology. Thus, this passage does *not* teach or suggest communications *between* medicine containers. Moreover, as explained above, de la Huerga teaches that physical contact is required between the contacts of a medicine container and the contacts of a dispenser unit so that the dispenser can communicate with each medicine container. There is *no* teaching or suggestion of having a first medicine container for storing a first medicine wirelessly communicate with a second medicine container for storing a second medicine as required by claim 2. Accordingly, neither Reber nor de la Huerga, either alone or in combination, teaches or suggests this feature.

In addition, claim 2 recites:

the signal including an indication of a number of times that the second container is beyond a range in which the first container is able to communicate with the second container; and

generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine.

The Examiner admitted that Reber does not disclose such features (see Office Action mailed on January 17, 2007 at page 5), and cited de la Huerga as purportedly disclosing these features. However, as explained above, neither Reber nor de la Huerga even suggests having a first container for storing medicine communicate with another container for storing medicine. Thus, Appellants respectfully submit that each of the cited references *fails* to teach or suggest a wireless signal including an indication of the number of times that medicine containers are out of communication range with each other, much less generating a code based in part on the signal wherein the code indicates whether a party has complied with a schedule for taking medicine.

Furthermore, the portion of de la Huerga cited by the Examiner (Fig. 42; col. 47, lines 11-43; and col. 48, lines 10-27) does *not* teach or suggest anything even remotely related to indicating a number of times something is beyond a range for communicating with something else. In fact, Appellants submit that de la Huerga cannot teach such a feature because each of the systems described by de la Huerga requires contacts on each medicine container to come into physical or electrical contact with the contacts of a console in order to communicate information.

Yet further, with regard to the feature of claim 2 of generating a code indicating whether a party has complied with a schedule for taking the medicines, the portion of de la Huerga cited by the Examiner (col. 52, lines 40-64) merely describes how the dispenser 1310 signals an indicator light 136 (which is on the dispenser itself; see Fig. 42) to alert a patient to consume medication from a medicine container 1100. It is apparent that the medicine container 1100 must be docked next to that indicator light 136 for such a system to function properly. Consequently, de la Huerga does not teach or suggest generating a code that indicates that a patient has complied with a schedule for taking the medications, as recited by claim 2.

In view of the above remarks, Appellants respectfully submit that the cited art does *not* teach or suggest the features recited by claim 2. Accordingly, the rejection of claim 2 under Section 103(a) cannot stand. In addition, dependent claims 3 and 5-47 should be allowable for at least the same reasons as claim 2.

2. Independent Claim 49 is Patentably Distinct From the Cited References

Independent claim 49 is directed to a medicine container that includes:

a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container.

For the sake of brevity, Appellants incorporate by reference herein the arguments presented above concerning claim 2. In particular, neither Reber nor de la Huerga teaches or suggests a first medicine container configured to wirelessly communicate with a second medicine container. Accordingly, claim 49 should be allowable over the cited references for at least the same reasons as claim 2. In addition, dependent claim 50 should also be allowable for at least the same reasons.

3. Independent Claim 116 is Patentably Distinct From the Cited References

Independent claim 116 is directed to a method that includes:

obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine; and

storing a first medicine in the first container.

For the sake of brevity, Appellants incorporate by reference the arguments above made with regard to claim 2 explaining that neither Reber nor de la Huerga teaches or suggests a first medicine container configured to wirelessly communicate with a second medicine container. Accordingly, claim 116 should be allowable over the cited references for at least the same reasons as claim 2. In addition, each of claims 117-125 directly or indirectly depends upon claim 116, and thus these claims should be allowable for at least the same reasons.

III. Conclusion

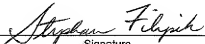
Applicants respectfully request review and reversal of all of the 35 U.S.C. §103(a) rejections of the pending claims.

Respectfully submitted,

December 21, 2007
Date

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 00-007						
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Application Number 09/609,253	Filed June 30, 2002							
First Named Inventor Jay S. Walker								
Art Unit 3627	Examiner Frenel, Vanel							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 33,384 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: center;">  _____ Signature Stephan J. Filipek _____ Typed or printed name (203) 461-7252 _____ Telephone number December 21, 2007 _____ Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>								
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.								

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